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ROGITZ & ASSOCIATES
750 B STREET
SUITE 3120
SAN DIEGO, CA 92101

EXAMINER	
LONSBERRY, HUNTER B	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/802,635
Filing Date: March 09, 2001
Appellant(s): KITSUKAWA, TADAMASA

John Rogitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/18/2006 appealing from the Office action mailed 3/23/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The amendment after final rejection filed on 4/27/06 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,144,376	Connelly	11-2000
6,067,564	Urakoshi et al.	05-2000
5,289,271	Watson	02-1994
2004/0249726	Linehan	12-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-3, 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly (US Pat No 6,144,376) in view of Urakoshi (US Pat No 6,067,564), and further in view of Watson (us Pat No 5,289,271).

In regard to claim 1, Connelly discloses "a method and apparatus for merging, displaying and accessing PC content listings via a television user interface. "PC content" in the context of this application include Internet listings, Web sites, local or on-line games and any other PC content available to PC users" (Col2, Lines 61-66). Connelly further discloses a table listing plural virtual channel shown in Figure 4.

The claimed step of "enabling the consumer to use a television to access content associated with a virtual channel" is met by Figures 4 and 3B. "FIG. 4 illustrates the method and apparatus of the present invention in further detail. Display 300 is coupled to processing unit 400 and is controlled via remote control 175. As illustrated in FIG. 4, processing unit 400 is capable of making a connection to the Internet, Processing unit 400 may be a computer system such as illustrated in FIG. 2 or any other form of processing unit that can perform the functions required to access a television channel and a PC. Display 300 replaces the television set in the user's living room, and can be

utilized for all normal television viewing as well as to access PC content" (Col 5, Lines 13-24; also see: Col 4, Line 34 - Col 5, Line 12).

The Connelly reference fails to explicitly disclose "establishing a access restriction table", "selectively restricting access to content using the access flags" and "each access flag indicating whether the channel can be accessed based on user ID".

Urakoshi teaches "establishing a access restriction table", "selectively restricting access to content using the access flags" and "each access flag indicating whether the channel can be accessed based on user ID" so as to allow parents to control the content that their child accesses. "On the program purchase screen 60, a personal identification number (personal code) and a password corresponding to the personal identification number are inputted (step 53). When the combination thereof matches the one stored, the purchase of the programs is permitted" (Col 5, Lines 9- 14; also see: Col 6, Lines 22-44; Col 6, Lines 52-67; Col 8, Lines 15-41).

Consequently, it would have been obvious to one of ordinary skill in the art to implement Connelly with "establishing a access restriction table", "selectively restricting access to content using the access flags" and "each access flag indicating whether the channel can be accessed based on user ID" for the stated advantage.

The aforementioned combined teaching fails to explicitly disclose recording a portion of the content accessed and a time of access record and billing the customer based on the on the record.

Watson teaches recording a portion of the content accessed and a time of access record and billing the customer based on the on the record so as to enable

subscribers to be charged a fee based upon their actual usage rather than a flat rate. "The invention is an apparatus for (1) recording the specific channels to which the device is tuned; and (2) the periods of time for which it is tuned to each respective channel; and (3) for periodically reporting the information, in time units allocated to each channel, to the originator of the cable signal; (4) all without participation by the individual cable user; and (5) without the necessity of intrusion into the individual turning circuit" (Col 3, Lines 54-61). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with recording a portion of the content accessed and a time of access record and billing the customer based on the on the record for the stated advantage.

In regard to claim 2, the claimed step of "enabling a consumer to use a television to access content provided by at least one web site and at least one television signal source" is met by Figures 4 and 3B (See: Col 5, Lines 13-24; Col 4,Line 34 - Col 5, Line 12).

The Connelly reference fails to explicitly disclose an access restriction table. Urakoshi teaches an access restriction table so as to allow parents to control the content that their child accesses (See: Col 5, Lines 9-14; Col 6, Lines 22-44; Col 6, Lines 52-67; Col 8, Lines 15-41). Consequently, it would have been obvious to one of ordinary skill in the art to implement Connelly with an access restriction table for the stated advantage.

The aforementioned combined teaching fails to explicitly disclose recording a portion of the content accessed and a time of access record and billing the customer based on the on the record.

Watson teaches recording a portion of the content accessed and a time of access record and billing the customer based on the on the record so as to enable subscribers to be charged a fee based upon their actual usage rather than a flat rate. "The invention is an apparatus for (1) recording the specific channels to which the device is tuned; and (2) the periods of time for which it is tuned to each respective channel; and (3) for periodically reporting the information, in time units allocated to each channel, to the originator of the cable signal; (4) all without participation by the individual cable user; and (5) without the necessity of intrusion into the individual turning circuit" (Col 3, Lines 54-61). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with recording a portion of the content accessed and a time of access record and billing the customer based on the on the record for the stated advantage.

Claim 3 is met by that discussed above for the method of claim 2.

In regard to claim 5, as discussed for claim 2, Urakoshi discloses restricting access to content using an "access flag" or indicator in order to allow parents to control the content that their child accesses (See: Col 5, Lines 9-14; Col 6, Lines 22- 44; Col 6,

Lines 52-67; Col 8, Lines 15-41).

In regard to claim 7, Watson discloses storing the user access information in storage element 34. Storage element stores information in an organized fashion, hence storage element 34 meets the limitation of a database.

In regard to claim 8, Watson discloses retrieving the access record from the database. "The information of a positive reception by receiver 26 and the time measured by counter 30 are then transmitted to a storage element 34. The indication of a particular frequency and the time units during which the particular frequency is received by cable usage box 12 is transmitted from storage element 34 to output element 28. Output element 28 provides appropriate formatting for a digital word, which is in turn modulated with an appropriate radio frequency for transmission of the stored information. Control module 32 periodically directs output element 28 to transmit the appropriately formatted information through trunk cable 20 upon request to the origination center 14" (Col 5-6, Lines 61-7). The subscriber is billed based on the access record; therefore the billable content has been determined.

Claim 9 is met by that discussed for the method of claim 2.

2. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly in view of Urakoshi further in view of Watson, and further in view of Linehan

(US Pat Pub No 2004/0249726).

In regard to claims 4, the combined teaching discloses enabling a consumer to use a television to access content provided by an online service and a television signal source with a subscriber interface for maintaining a virtual channel table having entries for a plurality of virtual channel numbers where the access of content is recorded.

The combined teaching is silent with respect to billing the owner of the content accessed.

Linehan teaches billing the owner of accessed content so as to generate revenue for the cable provider (See Paragraph 0033). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with billing the owner of accessed content for the stated advantage.

3. Claims 11-12 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly in view of Goodwin further in view of Watson.
In regard to claims 11-12, the aforementioned combined teaching fails to explicitly disclose recording a portion of the content accessed and a time of access record and billing the customer based on the on the record.

Watson teaches recording a portion of the content accessed and a time of access record and billing the customer based on the on the record so as to enable subscribers to be charged a fee based upon their actual usage rather than a flat rate. "The invention is an apparatus for (1) recording the specific channels to which the device is tuned; and (2) the periods of time for which it is tuned to each respective channel; and (3) for periodically reporting the information, in time units allocated to each channel, to the originator of the cable signal; (4) all without participation by the individual cable user; and (5) without the necessity of intrusion into the individual turning circuit" (Col 3, Lines 54-61). Consequently, it would have been obvious to one of ordinary skill in the art to implement the combined teaching with recording a portion of the content accessed and a time of access record and billing the customer based on the on the record for the stated advantage.

In regard to claim 14, as discussed for claims 10, Watson discloses restricting access to content using an "access flag" or indicator in order to allow parents to control the content that their child accesses.

Claim 15 is met by that discussed for the method of claim 10.

In regard to claim 16-18, Watson further discloses storing the user access information in storage element 34 and subsequently retrieving the information. Storage element stores information in an organized fashion, hence storage element 34 meets

the limitation of a database. "The information of a positive reception by receiver 26 and the time measured by counter 30 are then transmitted to a storage element 34. The indication of a particular frequency and the time units during which the particular frequency is received by cable usage box 12 is transmitted from storage element 34 to output element 28. Output element 28 provides appropriate formatting for a digital word, which is in turn modulated with an appropriate radio frequency for transmission of the stored information. Control module 32 periodically directs output element 28 to transmit the appropriately formatted information through trunk cable 20 upon request to the origination center 14" (Col 5-6, Lines 61-7). The subscriber is billed based on the access record; therefore the billable content has been determined.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Connelly in view of Goodwin further in view of Watson and further view of Linehan. In regard to claim 13, the combined teaching discloses enabling a consumer to use a television to access content provided by an online service and a television signal source with a subscriber interface for maintaining a virtual channel table having entries for a plurality of virtual channel numbers where the access of content is recorded. The combined teaching is silent with respect to billing the owner of the content accessed. Linehan teaches billing the owner of accessed content so as to generate revenue for the cable provider (See Paragraph 0033). Consequently, it would have been obvious to

one of ordinary skill in the art to implement the combined teaching with billing the owner of accessed content for the stated advantage.

(10) Response to Argument

Only those arguments raised by the appellant pursuant to the issues on appeal and directed towards the interpretation of particular claim limitations have been considered and addressed by the examiner. Any further arguments, that the appellant could have made concerning other claim limitations and/or other rational for a prima facie case of obviousness having not been made (ex. teaching away, long standing need, etc.) are considered as having been conceded by the appellant for the basis of this appeal and are not being subsequently addressed by the examiner for the Board's consideration.

(a) - Rejection using combination Connelly, Urakoshi et al., and Watson. As set forth in the rejection, Connelly discloses "a method and apparatus for merging, displaying and accessing PC content listings via a television user interface. 'PC content' in the context of this application include Internet listings, Web sites, local or on-line games and any other PC content available to PC users" (Col 2, Lines 61-66). Connelly discloses a table listing plural virtual channel shown in Figure 4.

As set forth in the rejection Urakoshi discloses a cable television access control system where "... an arrangement is made so that a particular user cannot change his own charge limit without inputting another user's password. For example, this allows

only parents in a family to set or change a charge limit for children in the family. By doing so, viewing of pay-per-view programs for children can be controlled by the parents" (Col 4, Lines 17-24). Urakoshi further discloses an access restriction table as shown in Figure 12. Each program in Figure 12 has an external flag, indicated by color, which informs the user of restrictions (Col 7, Lines 44-59). Each program has a program data set 111 (shown in Figure 11), which has a plurality of flags that in conjunction with the user's ID and password will either allow (or prevent) the channel that the program is on to be displayed.

As set forth in the rejection, Watson discloses a television usage system for charging a user based on actual usage contained in a billing record. Watson is not limiting to the type of information transmitted over the channel.

Appellant states "Connelly has been used as a teaching of a TV that shows conventional and virtual channels. It admittedly says nothing about an access restriction table and restricting content using flags in the table, much less flags that are tied to user ID. Urakoshi has been resorted to for these missing elements, but Urakoshi nowhere mentions virtual channels. If Urakoshi nowhere mentions virtual channels and Connelly nowhere mentions the access restriction table; there is only one place that a suggestion can come from to arrive at a modification unsuggested by either reference wherein the restriction table lists virtual channels: the present specification ."

In response, the Rejection does not rely upon Urakoshi to teach virtual channels, as alleged by appellant. Instead, Connelly clearly discloses virtual channels. The Rejection does not rely upon Conneily to teach the access restriction table. Instead, Urakoshi clearly discloses an access restriction table. One of ordinary skill in the art would have recognized that it is advantageous to allow parents to control the content that their child accesses.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant states "[a]s if to make Appellant's point, the rejections laconically give, as the sole motivation to combine the references, 'for the stated advantage.' What stated advantage? In what reference?"

In response, the rejection states Urakoshi teaches an access restriction table so as to allow parents to control the content that their child accesses. The motivation to

one of ordinary skill in the art to implement the virtual channel system of Connelly with the access control system of Urakoshi is to allow parents to control the content that their child accesses.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Appellant states, "[f]urthermore, the relied-upon program purchase menu 60 of Urakoshi has no flags for each channel."

In response, the examiner disagrees. The program data set 111 (Figure 11; Col 8, Lines 15-41) contain flags relating to the restriction of a user. The personal data (Col 4, Lines 17-63) in conjunction with the program data will determine if the program on a channel can be displayed. The color of the displayed program (which is a visual flag) is indicative of the flags associated with the program data set (Col 9, Lines 4-10, 50-54). Appellant states, "relied-upon portion of Watson says nothing about virtual channel, but

instead is directed to reporting channel usage to cable providers for unstated purposes."

In response, Watson is not relied upon to teach virtual channels. Watson teaches creating a billing record based on subscriber usage that in combination would result in recording the usage of a channel, regardless of the type of information (broadcast, web site, etc.) sent to the user. One of ordinary skill in the art would have recognized the advantage of the system of Watson enabling subscribers to be charged a fee based upon their actual usage rather than a flat rate.

Appellant again states "[a]s if to make Appellant's point, the rejections laconically give, as the sole motivation to combine the references, 'for the stated advantage.' What stated advantage? In what reference?"

In response, the rejection states Watson teaches recording an access record based on consumer access related to the content and billing an entity based on the record so as to enable subscribers to be charged a fee based upon their actual Usage rather than a flat rate. The motivation to one of ordinary skill in the art to implement the combination of Connelly and Urakoshi with recording an access record based on consumer access related to the content and billing an entity based on the record is to enable subscribers to be charged a fee based upon their actual usage rather than a flat rate.

(b) - Rejection using combination Connelly, Urakoshi et al., Watson, and Linehan.

Appellant states "Claim 4 is further patentable because the relied-upon paragraph 33 of Linehan simply states that TV originators 'may hope' to receive a percentage of sales from merchants."

In response, the Examiner respectfully disagrees because Linehan teaches billing an entity associated with the content provider (i.e. the Merchant Located on the Web 170, Fig 2). When the viewer accesses a private site (i.e. a secure purchase) entity associated with the content is billed in order to increase revenue for the TV originators (See Paragraphs 0033, 0038-0039, 0063). One of ordinary skill in the art would have recognized the advantage of the system of Linehan enabling TV originators to increase revenues by billing content owners based on viewers accessing their web site via a secure purchase.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Hunter B. Lonsberry/

Primary Examiner Art Unit 2421

Conferees:

John Miller

/John W. Miller/

Supervisory Patent Examiner, Art Unit 2421

Scott Beliveau

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2427